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I. STATUS OF CLAIMS

Claims 1-11 and 13 were pending at the time of the Office Action (15 November 2011).

Claims 1-11 and 13 stand rejected under 35 U.S.C. 112, first paragraph, as allegedly being unpatentable for failure to comply with the written description requirement. *See* Office Action, pp. 3-5. Applicant disagrees and traverses this rejection.

Claims 1-11 and 13 stand rejected under 35 U.S.C. 112, second paragraph, as allegedly being unpatentable for "failing to particularly point out and distinctly claim[ing]" the subject matter. *See* Office Action, pp. 6-7. Applicant disagrees and traverses this rejection.

No claim is amended, canceled, withdrawn or newly added herein. Claims 1-11 and 13 remain pending. No new matter has been added.

Applicant is aware that the USPTO is familiar with the MPEP standards. Below, Applicant is merely setting forth certain MPEP standards to serve as a framework for Applicant's arguments and to ensure a complete written record is established. Should the USPTO disagree with Applicant's characterization of the MPEP standards, Applicant respectfully request correction.

II.   ARGUMENT: CLAIMS 1-11 AND 13 RECITE LANGUAGE SUFFICIENT TO
       COMPLY WITH THE WRITTEN DESCRIPTION REQUIREMENT OF 35
       U.S.C. § 112, FIRST PARAGRAPH; EXAMINATION ON THE MERITS OF
       THE CLAIMS IS RESPECTFULLY REQUESTED

Applicant reminds the USPTO that the originally filed claims also form part of the specification, and support for claim amendments may find support in the claims as originally filed. MPEP 608.01(l) states this principle:

> "In establishing a disclosure, applicant may rely not only on the description and drawing as filed but also on the original claims if their content justifies it.
>
> "Where subject matter not shown in the drawing or described in the description is claimed in the application as filed, and such original claim itself constitutes a clear disclosure of this subject matter, then the claim should be treated on its merits . . . [t]he claim should not be attacked either by objection or rejection because this subject matter is lacking in the drawing and description."

Now, Applicant answers the specific rejections made pursuant to 35 U.S.C. § 112, first paragraph.

CLAIM 1 – NON-FIXED FIELDS

The USPTO rejects claim 1 on the basis that the specification allegedly fails to disclosed or fairly suggest a "non-fixed data input field." See Office Action, p. 3. Applicant respectfully disagrees and traverses this rejection.

Applicant asserts that the claims, as previously presented, recite language that (1) was included in the specification (including the claims as originally filed), and (2) complies with the written description requirement of 35 U.S.C. § 112, first paragraph. As to a "non-fixed field," the application, as originally filed, included such language. For example, in the abstract, it stated a "method of a . . . processing[sic] . . . for forms with non-fixed fields." Later, the abstract states that objects "are preliminarily assigned to act as reference points for . . . data input fields." Whether a "field" is a "data input field" has no bearing on whether the field is "non-fixed." Accordingly, the language in the Abstract discloses a "non-fixed data input field" because it

discloses at least a "non-fixed field" and a "data input field." Applicant asserts that one of ordinary skill in the art would understand that a "non-fixed data input field" is contemplated by this portion of the Application (Abstract) as originally filed.

Further, on p. 5 of the Specification (as originally filed), it states in part, "the present invention consists in . . . pre-recognition of machine-readable forms of non-fixed layout," and the "mentioned shortcomings greatly reduce the use of known methods to find . . . **data input fields** in the image of the form of **non-fixed layout**," (emphasis added). Applicant asserts that one of ordinary skill in the art would understand that a "non-fixed data input field" is contemplated by this portion of the Application as originally filed, and as currently recited in Claim 1. Applicant respectfully asks the USPTO to withdraw this rejection for at least these reasons.

CLAIM 1 – MULTIPLE DATA INPUT FIELDS

The USPTO further rejects Claim 1, and states, in part, that "it is unclear where in the specification identifying multiple data input fields is specifically described as a step in the steps for defining a spatial location of a non-fixed data input field in the image of a filled-in form."

Applicant asserts that "identifying . . . [a] data input **field position** in the case of **multiple data input fields**," (emphasis added) as recited in Claim 1, finds support at least in Claim 1 as originally filed. In part, Claim 1, as originally filed, recited in part, "a step of defining location of at least one data input field relatively to at least one reference point, said step further comprising . . . identification of the said data input field position **in the case of multiple search result**[sic]," (emphasis added). Applicant's representative clarified by amendment submitted on 28 April 2011 that the "multiple search result," is a search for "data input fields" as contextually communicated in the language of Claim 1.

Further support for such change can be found at least in the Summary as originally filed (p. 2 of the originally filed application), and which states in pertinent part, "elements in the image of machine-readable form are preliminarily assigned to be used further as reference points for **searching data input fields**," (emphasis added). Applicant's representative urges the USPTO to overlook cosmetic grammatical and spelling errors as the Inventors and applicant's

former representative (at the time of filing of the application) are not native English speakers. Applicant respectfully asks the USPTO to withdraw this rejection for at least these reasons.

CLAIM 4

Claim 4 as previously presented recites:

"4.   The method as recited in claim 1, wherein in the case of multiple data input fields the said identification of each data input field is performed via setting up and accepting of hypotheses and compliance estimation of the form model."

The USPTO indicates that it "is unclear wherein[sic] in the specification it specifically discloses identifying multiple data input fields via setting up and accepting of hypotheses and compliance estimation of the form model."

Applicant reminds the USPTO that the claims, as originally filed, also forms part of the "specification," and thus can serve as the basis for showing "support" for a claimed invention and for support for subsequent claim amendments. If this statement is untrue, Applicant urges the USPTO to indicate where in MPEP that a contrary indication is found.

Claim 4, as originally filed, recited, "The method as recited in claim 1, wherein **in the case of multiple search result** [referring to multiple data input fields . . . as explained above in reference to Claim 1] the said identification is performed via setting up and accepting of hypotheses and compliance estimation with form model," (emphasis added). As can be seen, there is disclosure of a "multiple search result" or "multiple data input fields." The rest of the rejected language was filed as part of Claim 4 as originally filed. Accordingly, the USPTO could not reject based on lack of support for "setting up and accepting of hypotheses and compliance estimation of the form model," as indicated in the Office Action.

Further support for such change from "multiple search result" to "multiple data input fields," can be found at least in the Summary as originally filed (p. 2 of the originally filed application), and which states in pertinent part, "elements in the image of machine-readable form are preliminarily assigned to be used further as reference points for **searching data input**

fields," (emphasis added). Applicant respectfully asks the USPTO to withdraw the rejection of Claim 4 as previously presented for at least these reasons.

CLAIM 6

Claim 6 as previously presented recites:

"6.   The method as recited in claim 1, wherein a non-fixed data input field may be used as a reference point."

The USPTO states, "Claim 6 is further rejected under 112(1st). The rejection of claim 1 provided in paragraph 5 above again applies for claim 6. Explanation of how or where this limitation is described in the specification is required."

Applicant asserts that there is abundant support for the amendments previously made to Claim 6. Claim 6 originally recited, in part, "wherein the **data input field** may be used as a reference point," (emphasis added). This language was clarified to be consistent with the **originally filed** language of Claim 1, which recited in part – and with emphasis added – a "method of pre-processing of a machine-readable form image with **non-fixed fields.**" Accordingly, Claim 6 was amended to recite a "non-fixed data input field" to avoid any ambiguity and to provide proper antecedent basis for claim terms. Applicant respectfully asks the USPTO to withdraw the rejection of Claim 6 as previously presented for at least these reasons. The USPTO is welcome to suggest how best to clarify the language recited in this claim.

CLAIM 7

Claim 7 as previously presented recites:

"7.   The method as recited in claim 1, wherein identifying each data input field in the case of multiple data input fields is performed at least partly manually."

The USPTO states, it "is unclear wherein in the specification it specifically discloses identifying multiple data input fields is performed at least partly manually." It appears that the

USPTO rejects the amendment from "multiple identification result[sic]" to "multiple data input fields." Applicant refers the USPTO to the explanation above in regard to Claim 1.

Further, Applicant asserts that "**multiple data input fields**," (emphasis added) as recited in Claim 7, finds support at least in Claim 1 as originally filed. In part, Claim 1, as originally filed, recited in part, "a step of defining location of at least one data input field relatively to at least one reference point, said step further comprising . . . identification of the said data input field position **in the case of multiple search result**[sic]," (emphasis added). Applicant's representative clarified by amendment submitted on 28 April 2011 that the "multiple search result," is a search for "data input fields" as contextually communicated in the language of Claim 1.

Further support for the amendment made to Claim 7 can be found at least in the Summary as originally filed (p. 2 of the originally filed application), and which states in pertinent part, "elements in the image of machine-readable form are preliminarily assigned to be used further as reference points for **searching data input fields**," (emphasis added). Based on at least this support in the originally filed application, a "multiple search result" may be amended to "multiple data input fields," as recited in Claim 7. Applicant respectfully asks the USPTO to withdraw the rejection of Claim 7 as previously presented for at least these reasons.

CLAIM 8

Claim 8 as previously presented recites:

"8.   The method as recited in claim 1, wherein the spatial location of a reference point is not fixed from a first scan of the machine-readable form to a second scan of the machine-readable form."

The USPTO alleges that the "use of the limitation 'from a first scan of the machine-readable form to a second scan of the machine-readable form' is not described in the specification." Applicant disagrees and traverses this rejection.

Applicant asserts that the claims as originally filed and the specification as originally filed provide adequate support for the language of claim 8 that the USPTO complains about. In

reference to claim 8, the language "the spatial location of a reference point is not fixed from a first scan of the machine-readable form to a second scan of the machine-readable form" is referred to as "clause [a]." Support for clause [a] can be found at, for example, on p. 4 of the specification, wherein it is permitted to have "structural variations" in forms.

Further support can be found at p. 5 of the specification as originally filed. In particular, it discloses a form of "non-fixed layout." To one of ordinary skill in the art, "non-fixed layout" includes within its meaning that the form can vary one form to another. Since Claim 1 as originally filed states that the method is for or of a "machine-readable form image with non-fixed fields layout," this equates to clause [a] of previously presented Claim 8.

As disclosed in MPEP 2163.02, the "test for sufficiency of support in a parent application is whether the disclosure of the application relied upon 'reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.'" *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)).

Further, MPEP 2163.02 states that the "subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement." Consequently, Applicant is not limited to the exact text and expressions as found in the original application when making claim amendments.

These amendments sufficiently clarify the subject matter so as to enable the USPTO to examine the claims on their merits in view of 35 U.S.C. 102, *et seq.* In view of the foregoing, Applicant respectfully requests withdrawal of the rejection of Claim 8 and further consideration of the Claim 8 as previously presented.

CLAIM 13

Claim 13 as previously presented recites:

"13.   The method as recited in claim 1, wherein the identifying each data input field position in the case of multiple data input fields is a profound identification."

Applicant asserts that the claims, as previously presented, recite language that (1) was included in the specification (including the claims as originally filed), and (2) complies with the written description requirement of 35 U.S.C. § 112, first paragraph. As to "wherein the identifying each data input field position . . . is a profound identification," support can be found at least in originally filed Claim 1. In relevant part, the last portion of Claim 1 recited, "profound identification of the said data input field position in the case of multiple search result." Applicant respectfully asks the USPTO to withdraw this rejection of Claim 13 for at least this reason.

III. ARGUMENT: 35 U.S.C. § 112, SECOND PARAGRAPH, ISSUES HAVE BEEN ADDRESSED; EXAMINATION ON THE MERITS OF THE CLAIMS IS RESPECTFULLY REQUESTED

Claims 1-11 and 13 stand rejected under 35 U.S.C. 112, second paragraph, as allegedly being unpatentable for "failing to particularly point out and distinctly claim[ing]" the subject matter. *See* Office Action, pp. 6-7. Applicant disagrees and traverses the rejections made under 35 U.S.C. § 112, second paragraph.

CLAIM 1 – "THE FORM"

The USPTO alleges that Claim 1 recites "two forms," and thus is indefinite. See Office Action, p. 6. Applicant disagrees and traverses this rejection.

Claim 1, as previously presented, recites (with emphasis added to all instances of "form" and "form model"):

"1.   A method of pre-processing of a machine-readable **form** with non-fixed fields layout, the method comprising:

acquiring a bit-mapped image of the machine-readable **form** filled in with print in one or more non-fixed data input fields;

identifying at least one **form model**, the at least one **form model** containing spatial and parametric properties of objects thereof;

preliminarily assigning at least one object of the **form** as a reference point for spatial binding of at least one non-fixed data input field thereof;

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eliminating any skew, distortion and noise in the bit-mapped image;

parsing the bit-mapped image into regions; and

defining a spatial location of at least one non-fixed data input field relative to at least one reference point, wherein said defining the location of the at least one non-fixed data input field comprises:

selecting a non-fixed data input field to search in the at least one **form model**;

accepting from the at least one **form model** at least one reference point property for a spatial relative reference of the said data input field;

searching and locating said at least one reference point on the **form** bit-mapped image;

searching and locating the said data input field on the **form** bit-mapped image relative to at least one reference point taking into account all spatial and parametrical properties described in the **form model**; and

identifying each data input field position in the case of multiple data input fields."

As can be seen, there is only one "form" and references to the "form" are indicated. While it is arguable that every instance of "form" must include the descriptor "machine-readable" with "form," it would be apparent to one of ordinary skill in the art that there is only one "form" recited in Claim 1. Likewise, there is only recitation of one "bit-mapped image" of the form, and one recitation of "form model." Based on these reasons, Applicant asserts that Claim 1 is not indefinite as to allegedly to instances of the "form." Applicant respectfully asks the USPTO to withdraw this rejection and consider this claim on its merits.

If Claim 1 as previously presented is not sufficiently written with clarity and succinctness (and according to the tastes of the USPTO) as to the "form," Applicant respectfully asks the USPTO for suggestions on how to improve the language of Claim 1.

CLAIM 1 – "DEFINING SPATIAL LOCATION"

The USPTO alleges that Claim 1 discloses "that both the image of the filled in form and the form model contain 'non-fixed data input fields' and it is therefore indefinite. The USPTO

refers specifically to the language, "defining a spatial location." See Office Action, p. 6. Applicant disagrees and traverses this rejection.

Claim 1, as previously presented, recites (with emphasis added to all instances of "non-fixed" and "form model"):

"1.   A method of pre-processing of a machine-readable form with **non-fixed fields** layout, the method comprising:
        acquiring a bit-mapped image of the machine-readable form filled in with print in one or more **non-fixed data input fields**;
        identifying at least one **form model**, the at least one form model containing spatial and parametric properties of objects thereof;
        preliminarily assigning at least one object of the form as a reference point for spatial binding of at least one **non-fixed data input field** thereof;
        eliminating any skew, distortion and noise in the bit-mapped image;
        parsing the bit-mapped image into regions; and
        defining a spatial location of at least one **non-fixed data input field** relative to at least one reference point, wherein said defining the location of the at least one **non-fixed data input field** comprises:
            selecting a **non-fixed data input field** to search in the at least one **form model**;
            accepting from the at least one form model at least one reference point property for a spatial relative reference of the said **[non-fixed] data input field**;
            searching and locating said at least one reference point on the form bit-mapped image;
            searching and locating the said **[non-fixed] data input field** on the form bit-mapped image relative to at least one reference point taking into account all spatial and parametrical properties described in the **form model**; and
            identifying each **[non-fixed] data input field position** in the case of multiple data input fields."

As can be seen, any possible ambiguity in the expression "defining a spatial location of _____ relative to at least one reference point" in reference to a "form model" or "bit-mapped image," is sufficiently overcome with attention to the following portion of Claim 1:

"preliminarily assigning at least one object of the form as a **reference point** . . .
. . .
"defining a **spatial location** of at least one non-fixed data input field relative to at least one **reference point** . . ."

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It appears from this explicit language recited in this claim that the "spatial location" is addressed relative to "the form." Thus, there is no ambiguity in this regard to support a rejection based on 35 U.S.C. § 112, second paragraph.

As to any ambiguity where "non-fixed data input fields" are located or chosen from, Claim 1 contemplates that that either or both the "bit-mapped image" of the form and the "form model" may have such fields. Whether a "field" or reference to a "field" originates from either the "image" or the "form model," such is of no consequence as to the expression of Claim 1 that recites, "selecting a **non-fixed data input field** to search in the at least one **form model**," (emphasis added). As is evident from the language of this claim as previously presented, Claim 1 contemplates "selection" of such a "field" from either the "image" or the "form model." There are only 2 options. Consequently, there is no "ambiguity" because one of ordinary skill in the art would understand what is meant and would only have 2 sources to choose from. Based on these reasons, Applicant asserts that Claim 1 is not indefinite as to allegedly to instances of the "form." Applicant respectfully asks the USPTO to withdraw this rejection and consider this claim on its merits.

Alternatives and some level of flexibility in claims is acceptable. Language is inherently imperfect. MPEP 2173.05(h) teaches that some alternative claim limitations are allowed. Applicant asserts that the USPTO is being overly critical of the expressions of Claim 1, and respectfully urges cooperation from the USPTO.

If Claim 1 as previously presented is not sufficiently written with clarity (and according to the tastes of the USPTO), Applicant respectfully asks the USPTO for suggestions on how to improve the language of Claim 1.

CLAIM 1 – "MULTIPLE DATA INPUT FIELDS"

The USPTO alleges that Claim 1 refers to "multiple data input fields" in both the image of the filled in form and form model, and therefore Claim 1 is indefinite as to which is referred to. See Office Action, p. 6. Applicant disagrees and traverses this rejection.

Claim 1, as previously presented, recites (with emphasis added to all instances of "multiple data input fields"):

"1.   A method of pre-processing of a machine-readable form with non-fixed fields layout, the method comprising:
            acquiring a bit-mapped image of the machine-readable form filled in with print in one or more non-fixed data input fields;
            identifying at least one form model, the at least one form model containing spatial and parametric properties of objects thereof;
            preliminarily assigning at least one object of the form as a reference point for spatial binding of at least one non-fixed data input field thereof;
            eliminating any skew, distortion and noise in the bit-mapped image;
            parsing the bit-mapped image into regions; and
            defining a spatial location of at least one non-fixed data input field relative to at least one reference point, wherein said defining the location of the at least one non-fixed data input field comprises:
                  selecting a non-fixed data input field to search in the at least one form model;
                  accepting from the at least one form model at least one reference point property for a spatial relative reference of the said [non-fixed] data input field;
                  searching and locating said at least one reference point on the form bit-mapped image;
                  searching and locating the said [non-fixed] data input field on the form bit-mapped image relative to at least one reference point taking into account all spatial and parametrical properties described in the form model; and
                  identifying each [non-fixed] data input field position in the case of **multiple data input fields**."

Any indefiniteness as to "image" or "form model" in reference to "multiple data input fields" is sufficiently overcome with attention to the following portion of Claim 1:

"searching and locating the said [non-fixed] data input field **on the . . . image** relative to at least one reference point taking into account all spatial and parametrical properties described in the form model; **and**

"identifying **each [non-fixed] data input field position** in the case of multiple data input fields."

The express language of this claim appears to indicate that the "searching" and "locating" and "identifying" is in reference to the "image." The "searching" takes "into account all spatial and parametrical properties described in the form model." Such language seems abundantly clear. Applicant asserts that one of ordinary skill in the art would not find ambiguity (neither latent ambiguity or apparent ambiguity) within the language of Claim 1 as previously presented. For at least these reasons, Applicant asserts that Claim 1 is not indefinite as to "each data input field." Applicant respectfully asks the USPTO to withdraw this rejection and consider this claim on its merits.

If Claim 1 as previously presented is not sufficiently written with clarity and succinctness (and according to the tastes of the USPTO), Applicant respectfully asks the USPTO for suggestions on how to improve the language of Claim 1 in regard to "non-fixed data input fields."

CLAIM 6

The USPTO rejects Claim 6 on substantially the same basis as Claim 1 (above). Applicant asserts that the same reasons presented above are applicable to Claim 6. Accordingly, for at least these reasons, Applicant asserts that Claim 6 is also not indefinite.

DEPENDENT CLAIMS

The USPTO rejects certain dependent claims for being dependent from a rejected base claim. In such circumstances, Applicant asserts that the reasons provided above in support of overcoming the rejections of the independent claims also apply to the dependent claims. Consequently, Applicant respectfully asks the USPTO to withdraw the rejections of any dependent claims where the rejection of the respective base or independent claim is overcome.

IV. REMINDER: USPTO PERSONNEL SHOULD FOLLOW THE PROCEDURES DESCRIBED IN THE MPEP; EXAMINATION ON THE MERITS IS RESPECTFULLY REQUESTED

As Applicant demonstrated above, the USPTO failed to establish a *prima facie* case of lack of written description for the claims as previously presented. Pursuant to MPEP 2163, even "where Office personnel [does] establish a *prima facie* case of lack of written description for a claim, **a thorough review of the prior art and examination on the merits** for compliance with the other statutory requirements, including those of 35 U.S.C. 101, 102, 103, and 112, **is to be conducted prior to completing an Office action** which includes a rejection for lack of written description," (emphasis added). It appears to Applicant that such action has not been done in this case. Applicant respectfully requests fair consideration of the claims on their merits.

V. CONCLUSION

Applicant may have during the course of prosecution cancelled and/or amended one or more claims. Applicant notes that any such cancellations and/or amendments will have transpired (i) prior to issuance and (ii) in the context of the rules that govern claim interpretation during prosecution before the United States Patent and Trademark Office (PTO). Applicant notes that the rules that govern claim interpretation during prosecution form a radically different context than the rules that govern claim interpretation subsequent to a patent issuing. Accordingly, Applicant respectfully submits that any cancellations and/or amendments during the course of prosecution should be held to be tangential to and/or unrelated to patentability in the event that such cancellations and/or amendments are viewed in a post-issuance context under post-issuance claim interpretation rules.

Insofar as that the Applicant may have during the course of prosecution cancelled/amended claims sufficient to obtain a Notice of Allowability of all claims pending, Applicant may not have during the course of prosecution explicitly addressed all rejections and/or statements in Office Actions. The fact that rejections and/or statements may not be explicitly addressed during the course of prosecution should NOT be taken as an admission of any sort, and Applicant hereby reserves any and all rights to contest such rejections and/or

statements at a later time. Applicant hereby gives notice that it may intend to file and/or has filed a continuing application in order prosecute such cancelled/unamended claims.

With respect to any cancelled claims, such cancelled claims were and continue to be a part of the original and/or present patent application(s). Applicant hereby reserves all rights to present any cancelled claim or claims for examination at a later time in this or another application. Applicant hereby gives public notice that any cancelled claims are still to be considered as present in all related patent application(s) (e.g. the original and/or present patent application) for all appropriate purposes (e.g., written description and/or enablement).

Should this case go to appeal, Applicant reserves the right to submit argument, rebuttal evidence, or legal authority in the instance the Board of Patent Appeals and Interferences finds that the USPTO has met its burden in establishing a *prima facie* case of unpatentability of the various appealed claims. Applicant further reserves the right to submit argument, rebuttal evidence, or legal authority if new claim interpretations or definitional citations are raised on appeal. The fact that argument, rebuttal evidence, or legal authority may not have been explicitly discussed during the course of prosecution should NOT be taken as an admission or waiver of any sort, and Applicant hereby reserves any and all rights to discuss (e.g. make explicit, produce, or explain) such rebuttal evidence at a later time.

The USPTO is encouraged to contact the undersigned by telephone at (408) 457-9806 to discuss the above and any other distinctions between the claims and the applied references, if desired. Also, if the USPTO notes any informalities in the claims, it is encouraged to contact the undersigned to expediently correct such informalities.

Respectfully submitted,

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